

REMARKS

Applicants have amended claim 168 to more accurately claim the present invention, and have cosmetically amended claims 258 and 261. These amendments are not for any reason related to patentability. No new matter has been added. Applicants believe that the following comments will convince the Examiner that the rejections set forth in the August 13, 2003 Office Action have been overcome and should be withdrawn.

Furthermore, Applicants are submitting herewith a terminal disclaimer to limit the term of the patent resulting from this application to that of Applicants' U.S. Pat. No. 6,164,534 (the "'534 patent"). Applicants want to bring the '534 patent to the Examiner's attention since the Examiner may believe that its claims are not patentably distinct from (or in fact encompass) the present invention. Claim 1 from the '534 patent is illustrative:

1. A system for displaying programming to a user, the system comprising:

a printed matter having at least one machine recognizable feature;

a feature recognition unit having associated therewith a means for recognizing said feature and a transmitter for transmitting a coded signal in response to the recognition of said feature;

an intelligent controller having associated therewith a receiver for receiving said coded

signal and means for accessing programming material; and

5 a display unit for presenting said programming material;

10 wherein said recognition unit, in response to the recognition of said feature, causes said intelligent controller to access said programming material and said display unit to execute or display said programming material.

I. THE INVENTION

Generally, the present invention is a system for
15 accessing electronic data via a familiar printed medium. Specifically, the familiar printed medium is a printed advertisement comprising at least one machine recognizable feature, which may be one of various embodiments including, but not limited to, a watermark, bar code, invisible bar
20 code, magnetic code, printed character, invisible icon, etc. In the present invention, a machine recognizable feature is scanned or sensed, and converted into an electronic signal, which is transmitted for processing. In response to the electronic signal, programming material
25 related to the information contained in the printed advertisement is displayed. Importantly, the present invention is designed to allow a user (e.g., a shopper) to access programming material related to the printed advertisement.

II. THE EXAMINER'S REJECTIONS

The Examiner rejected claims 168-173, 176-178, 195, 196, 198, 212, 220, 227-230, 235-237, 240, 251, 256, and 258-261 under 35 U.S.C. § 103(a) as being unpatentable over Withnall et al. U.S. Patent No. 4,488,035 (hereinafter referred to as "Withnall") in view of Fields U.S. Patent No. 4,481,412 (hereinafter referred to as "Fields") and Tannehill et al. U.S. Patent No. 5,158,310 (hereinafter referred to as "Tannehill"). The Examiner opined that Withnall discloses a system that includes a feature recognition device that reads at least one machine recognizable feature printed on a travel ticket to display travel information on the display of a portable handset.

However, the Examiner admitted that:

"Withnall fails to teach or fairly suggest that the displayed information is programming material and the system further comprising means for transmitting a coded signal in response to the recognition of the machine recognizable feature and an intelligent controller having associated therewith a means for accessing the programming material in response to receiving the coded signal." (August 13, 2003 Office Action, p. 3).

The Examiner contended that Fields teaches these features by disclosing a microcontroller accessing means that includes a "barcode electronic circuit" coupled to a barcode reader, wherein the microcontroller accesses and

transmits programming material in response to receiving a coded signal. The Examiner argued that the system disclosed in Fields displays "video/image/programming/sound/pictorial/electronic/media data" on a "television/workbook." (August 13, 2003 Office Action, p. 4).

The Examiner stated that combining the systems disclosed in Withnall and Fields would have been obvious at the time of Applicants' invention:

10 "in order to provide Withnall with a higher technology system wherein the user being provided with complete information in flexible ways. . . . Furthermore, such modification would have been an obvious extension as taught by Withnall." (August 15 13, 2003 Office Action, p. 4).

The Examiner then admitted that Withnall and Fields fail to teach a system comprising a printed advertisement having a machine recognizable feature including a "magnetic code/strip," which the Examiner asserted is disclosed in 20 Tannehill. The Examiner argued that the combination of Tannehill with Withnall and Fields would have been obvious:

25 "to provide the consumer a convenient way of saving money by displaying an advertising program, which attracts people to shop. Such advertisement can lead to increasing number of customers and to generating increased revenues. In view of the above, retailers or business owners would be motivated to incorporate [a] 30 user-friendly advertisement system. Furthermore, such modification would provide Withnall/Fields with an alternative feature for encoding data

(i.e., barcode or magnetic strip). Accordingly, such modification would have mere[ly] been a substitution of equivalents." (August 13, 2003 Office Action, pp. 4-5).

5 Also, the Examiner rejected claims 174, 175, 180, 181, 183, 185, 189, 190, 192, 193, and 214-219 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Tannehill "as applied to claim 168" in view of
10 Roberts U.S. Patent No. 5,324,922 (hereinafter referred to as "Roberts") and Malec et al. U.S. Patent No. 5,287,266 (hereinafter referred to as "Malec"). The Examiner admitted that Withnall, Fields, and Tannehill fail to teach online or home shopping and a cable television data link,
15 and argued that Roberts disclose these features. According to the Examiner, the combination of Roberts with Withnall, Fields, and Tannehill would have been obvious and would provide:

20 "a faster system due to the benefit of cable television transmitting capability. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Tannehill to provide the user an alternative way of doing shopping." (August 13, 2003 Office Action, p.
25 5).

Moreover, the Examiner admitted that Withnall, Fields, Tannehill, and Roberts all fail to disclose an Integrated Service Digital Network ("ISDN") data link which, according
30 to the Examiner, is disclosed by Malec. In the opinion of

the Examiner, the combination of Malec with Withnall, Fields, Tannehill, and Roberts would have been obvious for providing:

5 "a more accurate and faster system due to the
benefit of ISDN networking lines. Furthermore,
such modification would have been an obvious
extension as taught by
Withnall/Fields/Tannehill/Roberts and would have
merely been a substitution of equivalents."
10 (August 13, 2003 Office Action, p. 6).

Next, the Examiner rejected claims 179, 182, 186-188,
191, 194, 199-201, 203, 204, 209, 210, 213, 221-226, 234,
239, 241-243, 254, and 257 under 35 U.S.C. § 103(a) as
15 being unpatentable over Withnall as modified by Fields and
Tannehill "as applied to claim 168" in view of Bravman et
al. U.S. Patent No. 5,401,944 (hereinafter referred to as
"Bravman"). The Examiner admitted that Withnall, Fields,
and Tannehill fail to teach displaying information related
20 to traveling on a wireless communication device. According
to the Examiner, Bravman teaches a remote unit providing
travel-related information, and the combination of
Withnall, Fields, Tannehill, and Bravman would have been
obvious for providing:

25 "a more flexible system wherein the system is
capable of providing the user all of his/her
desired information about the trip/vacation that
he/she is about to take, and thus providing a
more user-friendly system. Furthermore, such
30 modification would have been an obvious extension

as taught by Withnall/Fields/Tannehill." (August 13, 2003 Office Action, p. 7).

Also, the Examiner rejected claims 197, 202, and 205
5 under 35 U.S.C. 103(a) as being unpatentable over Withnall
as modified by Fields and Tannehill "as applied to claim
168" in view of Waterbury German Patent No. DE 24 52 202 A1
(hereinafter referred to as "Waterbury"). The Examiner
admitted that Withnall, Fields, and Tannehill fail to teach
10 an invisible machine recognizable feature, which the
Examiner asserted is taught by Waterbury. The Examiner
asserted that the combination of Waterbury with Withnall,
Fields, and Tannehill would be obvious for providing:

15 "a more secure system wherein the data recorded
in the machine recognizable feature is invisible
to the naked eye, thus preventing manipulating
[sic] by a fraudulent user. Furthermore, such
modification would have been an obvious extension
as taught by Withnall." (August 13, 2003 Office
20 Action, p. 7).

Additionally, the Examiner rejected claims 206-208 and
211 under 35 U.S.C. § 103(a) as being unpatentable over
Withnall as modified by Fields and Tannehill "as applied to
25 claim 168" in further view of Schach *et al.* U.S. Patent No.
5,397,156 (hereinafter referred to as "Schach") and
Waterbury. The Examiner admitted that Withnall, Fields,
and Tannehill fail to teach a watermark. However, the
Examiner asserted that watermarks are taught by Schach. In

the Examiner's opinion, the combination of Schach with "Withnall/Fields/Tannehill aesthetic purpose [sic]" would have been obvious. "[S]uch modification would have been an obvious extension as taught by Withnall/Fields/Tannehill."

5 (August 13, 2003 Office Action, p. 8).

The Examiner then admitted that Withnall, Fields, and Schach fail to teach an invisible watermark, which is argued to be taught by Waterbury. The Examiner asserted that the combination of Withnall, Fields, Tannehill,
10 Schach, and Waterbury would be obvious for providing:

"a more secure system wherein the data recorded in the machine recognizable feature is invisible to the naked eye, thus preventing manipulating [sic] by a fraudulent user. Furthermore, such
15 modification would have been an obvious extension as taught by Withnall/Fields/Tannehill/Schach."
(August 13, 2003 Office Action, pp. 8-9).

Also, the Examiner rejected claims 231-233, 238, 239,
20 244-250, 252, 253, 255, and 256 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Tannehill "as applied to claim 168" in view of Morales U.S. Patent No. 5,872,589 (hereinafter referred to as "Morales"). The Examiner admitted that Withnall, Fields,
25 and Tannehill fail to teach a display unit comprising a "personal planner/phone/pager," which the Examiner asserted is taught by Morales. In the Examiner's opinion, combining

Withnall, Fields, Tannehill, and Morales would be obvious to provide:

5 "the user with the flexibility of selecting his/her desired display unit that fits his/her needs, thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall/Fields/Tannehill." (August 13, 2003 Office Action, p. 9).

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III. **THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN**

The Examiner rejected claims 168-173, 176-178, 195-196, 198, 212, 220, 227-230, 235-237, 240, 251, 256, and 258-261 under 35 U.S.C. § 103(a) as being unpatentable over
15 Withnall, Fields, and Tannehill. Applicants respectfully disagree and submit that none of the aforementioned claims are obvious in view of Withnall, Fields, and Tannehill. In order for a claimed invention to be obvious in view of a combination of references, three criteria must be met: 1)
20 there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of the claim limitations (see *In re Vaeck*, 947 F.2d 488 (Fed.
25 Cir. 1991); MANUAL OF PATENT EXAMINING PROCEDURE §§ 2143-2143.03).

Initially, Applicants submit that no suggestion or motivation to modify or combine Withnall, Fields, and Tannehill exists.

5 "Standing on their own, these references provide no justification for the combination asserted by the Examiner. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 15 1984) (emphasis in original).

The Examiner contended that it would be obvious to combine the teachings of Withnall, Fields, and Tannehill to arrive at the various embodiments of Applicants' invention. Yet, the Examiner has cited only purported benefits of this combination without pointing to what motivation is provided by the references themselves. Applicants submit that no combination of these references would have been obvious to one of skill in the art at the time of Applicants' invention. Specifically, Withnall discloses a system for utilizing barcodes on commuter tickets to test for validity. The Examiner suggests that "travel information which can be retrieved once barcode [sic] on the ticket has been read can be broadly interpreted a[s] programming material...associated with the barcode." (August 13, 2003 30

Office Action, p. 10) Applicants respectfully submit however, that this does not constitute programming material. The "travel information" referred to by the Examiner is encoded within the barcode on the ticket. The
5 system of Withnall reads this information from the barcode, it does not retrieve it from a separate database. The barcode or the data encoded therein do not themselves constitute programming material. Indeed, the only interaction the barcode has with a database is a mere
10 validity check, i.e., the comparison of data on the ticket to stored reference data.

This purpose is far removed from the intent of the training system disclosed by Fields. The training system of Fields is used to provide a user with audio/visual
15 output from a videodisc player coinciding with material presented in a training manual. Fields relies on a read-only videodisc thereby sacrificing updatability and flexibility. In fact, Fields does not even contemplate the ability to interface with a remote server or an updatable
20 video source. Thus, there is no suggestion to combine a travel ticket verification system that does not provide programming material with a training system that automatically cues to a certain frame on a videodisc. The

mere fact that Fields and Withnall can use a barcode is an insufficient basis to suggest their combination.

Moreover, the ticket validation system of Withnall has no apparent relation to Tannehill's advertising system. Specifically, Tannehill discloses a shopping cart comprising a visual display for displaying advertisements to a shopper. Further, Tannehill teaches against the dynamic programming material of the present invention. (see Tannehill, col. 17, lines 1-3) The differing purposes of these three references have no overlap in use, and therefore, would not provide one skilled in the art with a motivation or suggestion to combine these references. Thus, an inventive step must be performed for one skilled in the art to arrive at the idea of combining any features of Withnall, Fields, or Tannehill in any combination.

Upon reconsideration, the Examiner will undoubtedly recognize that the reasons put forth for the § 103(a) rejection actually support an "obvious to try" argument. Of course, "obvious to try is not the standard for obviousness under 35 U.S.C. § 103." Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 91 (Fed. Cir. 1986).

Under these circumstances, we respectfully submit that the Examiner has succumbed to the "strong temptation to

rely on hindsight." Orthopedic Equipment Co. v. United States, 702 F. 2d 1005, 1012, 217, U.S.P.Q. 193, 199 (Fed. Cir. 1983):

5 "It is wrong to use the patent in suit as a guide
through the maze of prior art references,
combining the right references in the right way
so as to achieve the result of the claim in suit.
Monday morning quarterbacking is quite improper
when resolving the question of nonobviousness in
10 a court of law."

Applicants submit that the only suggestion or
motivation for the Examiner's combination of references is
provided by the teachings of Applicants' disclosure. No
15 such suggestion or motivation is provided by the references
themselves; nor could there be in view of the difference in
subject matter and the corresponding goals thereof.

In addition to the lack of suggestion or motivation to
combine Withnall, Fields, and Tannehill, there is no
20 expectation of success for the combination of these
references, and any possible resulting device would not
teach or suggest all of the limitations of the rejected
claims. Withnall discloses a machine capable of scanning a
bar code on a commuter ticket and subsequently displaying
25 the validity of the ticket based on information stored in a
memory means. Fields discloses a system reading a bar code
on a training manual for playing corresponding material

from a videodisc. Tannehill discloses a shopping cart having a visual display for displaying advertisements.

Applicants respectfully submit that the combination of Withnall, Fields, and Tannehill cannot be successfully
5 combined to disclose the dynamic programming material or the printed advertisement having a machine recognizable feature of the claimed invention. Importantly, claims 168, 256, and 259 all disclose the accessing of programming material related to an advertisement resulting from
10 recognition of a machine recognizable feature on the advertisement. The programming material of the present invention is designed such that it can be easily altered or updated at any time. As a result, a user is provided with the most recently updated version of the associated
15 information (or programming material) upon scanning an advertisement. This is not possible with the combination of Withnall, Fields, and Tannehill. Even if it were successful or proper to combine these three references (of course, Applicants believe the combination would not be
20 successful or proper), the combination would provide a system with static, not dynamic, audio/visual material. Specifically, if the audio/visual material were to come from the videodisc player of Fields, a videodisc player would be located on, for example, a bus. Therefore,

anytime information must be updated, a new videodisc must be inserted into the videodisc player. This is not feasible, especially because the validity of a ticket can change each time a ticket is used and could require a new
5 videodisc to be employed every time a ticket is used. In the case that the audio/visual material of Tannehill is used, it would be static, rather than dynamic, because the audio/visual material must be locally stored.

10 "[O]ne or more memory devices, not shown, composing part of the electronic display circuitry could be periodically conveniently replaced, with the new memory device containing the new material to be outputted on the display."
15 (Tannehill, col. 14, lines 40-44)(emphasis added).

Tannehill further states that "the display system 299 does not attempt to transmit information via airborne signals."
(col. 17, lines 1-3). Thus, Tannehill specifically
20 discloses a system where all matter for display is stored locally within the display circuitry. Therefore, Tannehill teaches against the dynamic programming material of the present invention because updating the stored matter would require individually updating the memory means within each
25 display of each shopping cart. Moreover, the radio data link of Withnall cannot be utilized to access a remote videodisc player or other such audio/visual material because the radio data link is designed only for

transmitting a validity state and not substantially different audio/visual material. In particular, audio/visual material requires substantially more data to be transmitted in a specialized format. Thus, a system for achieving such transmission would need to be invented and implemented for remotely accessing such material.

Additionally, a printed advertisement having a machine recognizable feature as claimed is not disclosed within the combination. Tannehill discloses a displayed advertisement having a code thereon. This, however, differs significantly from the printed advertisement of the claimed invention. In Tannehill, the code is used to determine which advertisement is displayed. A shopper using Tannehill's system would not be able to scan the disclosed code because the feature is contained within the display apparatus. Also, the displayed material contains the code, and therefore, the code is not useful for accessing the displayed material. In other words, a user could not reach the advertisement (or any other material) by using the code because it is physically affixed to the material it references. Therefore, any attempt to combine Withnall, Fields, and Tannehill to create the present invention would be unsuccessful and fail to provide the flexible, dynamic, updateable system of the claimed invention. Moreover, the

dynamic programming material and the printed advertisements comprising a machine recognizable feature of the claimed invention are not disclosed by the combination of these references.

5 The strength of this argument is made more clear in light of the Examiner's response to a similar argument made in the prior response:

10 "The Withnall Patent discloses a printed travel ticket having one machine recognizable feature such as a barcode. . . . [P]rogramming material disclosed in the Fields patent is more similar to the programming material cited in [the] instant application in that [the] captured barcode triggers [the] videodisc player to position
15 itself at [the] correct address location and read information. It is also Examiner's opinion that such ticket often includes advertisement material (for instance, the subway ticket in Metropolitan Washington area [is] imprinted with panda bears
20 in [the] National Zoo). Accordingly, incorporating advertisement material on fair tickets or other tickets (i.e., concert tickets, sports events) is widely used in real applications, and well within the ordinary skill
25 in the art." (August 13, 2003 Office Action, pp. 10-11) (citations omitted)

 Such an argument ignores the limitation in claims 258, 261 and currently amended claim 168 which requires that the
30 programming material be related to the advertisement. Applicants do not dispute that advertisements have been printed on tickets prior to their invention. However, the codes on tickets (including the Examiner's subway ticket) do not provide the user with programming material *related*

to the advertisement. The codes are instead integral to the tickets' function as tickets, e.g., they might indicate validity or duration. They are not associated with any programming material related to an advertisement printed on
5 the tickets.

In view of the foregoing, base claims 168, 256, and 259 cannot be unpatentable over Withnall, Fields, and Tannehill. The remaining rejected claims are dependent on these claims and contain all of the limitations of their
10 respective base claims. Therefore, these claims are also not unpatentable over these references.

In all subsequent rejections, the Examiner noted the deficiencies of the Withnall, Fields, and Tannehill combination regarding matter disclosed in dependent claims
15 and appended various other references including Roberts, Malec, Bravman, Waterbury, Schach, and Morales to the combination in order to provide the additional features of the dependent claims. However, the combination of Withnall, Fields, and Tannehill has been shown to be not
20 only improper, but also to lack the disclosure of each and every element of the base claims. Because this combination is improper and incomplete, any further combining of references to Withnall, Fields, and Tannehill would also be improper. Thus, Applicants respectfully submit that all

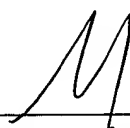
remaining rejections have also been overcome and should be withdrawn.

CONCLUSION

Applicants submit that all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. Early and
5 favorable action is accordingly solicited.

Respectfully submitted,

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